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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,003	12/14/2001	Masao Matsuda	PF-2852/PCT/US	7116
466 7590 12/29/2006 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER CASLER, TRACI	
			ART UNIT 3629	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/018,003

Applicant(s)

MATSUDA ET AL.

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to papers filed on September 29, 2006.

Claims 1, 4, 6, 12-16 have been amended.

Claim 5 has been cancelled.

The specification is objected.

Claims 1-4 and 6-16 are pending.

Claims 1-4 and 6-16 are rejected.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-16 recite limitations in which the disclosure does not teach how one skilled in the art would make the present invention. The claims list growth stage identification, the disclosure make reference to this limitation but fails to identify how one goes about identifying a "growth state" or what exactly is a growth state. The claims recite the limitation of "proficiency of study information", "study characteristics" and "study dependency" but again fail to teach how one would determine proficiency,

characteristics, and dependency as well as what exactly is proficiency, characteristics and dependency. Lastly, the claims recite the limitation of determining study items, it is understood by the examiner that the study items are what will be learned by the students or taught to the students. However, the disclosure fails to teach how to determine what each individual is to receive as study items. What factors effect the final decision for appropriate study items.

3. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 16 is teaching multiple study guidances, however, the disclosure merely teaches a single guidance. The use of multiple guidances leave the claims in a narrower scope than the disclosure; hence the disclosure would not lead one ordinary skill in the art to know that the single study guidance is the same as or different from the multiple guidances and how would one make the multiple as opposed to the single.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims fail to identify a concrete tangible result. The claims are a subjective process of evaluating an individuals knowledge or level of knowledge in various areas. The evaluation has no set parameters for determining how individuals fall into a level or category of knowledge therefore can not produce a concrete tangible result. Furthermore, the claims also invention also depends on a "presence or absence" or interest and eagerness of the individual regarding the individuals studies. Not only are there not concrete process for identifying an individuals "presence or absence" of interest and eagerness, these are an individuals emotions and thoughts. Emotions and thoughts fall with in the abstract idea of non-statutory subject matter. The individuals eagerness and/or interest can vary greatly depending or their state of being and their current life activities. An individual might not be very interested and/or eager to participate in a lesson when it is a beautiful day and they want to be outside. Whereas on a rainy day an individuals interest and/or eagerness could be higher because of a lack of other activities that interest them at the moment.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Cook et al; Agent Based Instruction System and Method. Hereinafter referred to as Cook. **\*\*THE EXAMINER NOTES BELOW WILL BEGIN A REJECTION OF THE PRIOR ART, HOWEVER THE REJECTION IS BASED ON THE EXAMINERS BEST UNDERSTANDING OF THE CLAIMS AND WHAT THE APPLICANT IS TRYING TO CLAIM AS WELL AS HOW APPLICANTS CLAIMS ARE PERFORMED IN VIEW OF THE VARIOUS REJECTIONS MADE ABOVE UNDER 35 USC 112 IST AND 35 USC 101.**

10. As to claims 1 and 12 Cook teaches a server system and method in which learners(students) and teaches are connected via a network and sharing lesson information as well as populating the appropriate lesson schedule for the individual students(C. 48 I. 61-65 and C. 49 I. 1-4).

11. **Cook teaches Cook teaches the types of material being presented to the user(student) being individualized to the students learning needs(Fig. 7 Materials Engine C. 38)**

12. **Cook further teaches presenting the materials to the learner in a timed manner based on the students progress with previous work(C. 38 I. 31-32; I. 63-65 and C. 39 I. 35-48).**

13. As to claim 2 Cook teaches the system and method over a communication network(Fig 2B; C. 18 l. 10-15)
14. As to claims 3 Cook teaches user id and password required for accessing the system(C. 48 l. 44-46).
15. As to claim 4 Cook teaches a schedule of lessons and training materials.(C. 34 l. 42-45).
16. As to claims 5 and 9 Cook teaches the types of material being presented to the user(student) being individualized to the students learning needs(Fig. 7 Materials Engine C. 38)
17. As to claim 6 Cook teaches information being provided to the student dependent on the students behavior.(C. 5 l. 45-54).
18. As to claim 7 Cook teaches databases containing all the necessary information for determining study plans(C. 29 l. 7-9).
19. As to claim 8 Cook teaches all the items/information used in determining a study plan for the information(C. 56 l. 26-30).
20. As to claim 10 Cook teaches the study plan including time lines, lessons and dates(start and finish) of materials to be used for the study plan.
21. As to claim 11 Cook teaches sending messages and reminders to the students regarding assignments(C. 29 l. 3-6).
22. As to claim 13 Cook teaches allowing a teacher to create, direct and assign materials and home work to individuals(C. 29 l. 43-49) and using the students progress on previous tasks to make changes and update information(C. 29 l. 64-67; C. 30 l. 1-3).

23. As to claim 14 Cook teaches the individual(student) accessing via an ID study materials.(C. 29 I. 6-9). The materials appear as the teach wishes them presented such as due dates access and results of previous work(C. 44 I. 23-24). **Cook further teaches presenting the materials to the learner in a timed manner based on the students progress with previous work(C. 38 I. 31-32; I. 63-65 and C. 39 I. 35-48).**

24. As to claim 15 Cook teaches reports generated in response to a students progress and work completed(C. 29 I. 64-67) as well as modifying the study materials based on reports(C. 30 1-3 & I. 28-52)

25. As to claims 16 Cook teaches agent adaptivity based on student performance and progress(C. 62 I 58-61) identifying time lines for tasks/ assignments set by study materials and (C. 63 I. 35-55) motivating students to complete tasks/assignments via messages and reminders(C. 29 I. 3-6).

### ***Response to Arguments***

26. Applicant's arguments filed September 29, 2006 have been fully considered but they are not persuasive.

27. Applicants arguments regarding the enablement rejections fail to identify how the invention is made. The applicant makes arguments regarding how to determine a "Study characteristic" however, the characteristic requires know how to measure a degree of interest and eagerness. Applicant fails to identify how these measures are done. Applicant argues that there is no requirement to be "unnecessarily specific"; this in fact is true; however contrary to applicants reasoning the disclosure does not teach how to determine what the level of a topic is appropriate. The disclosure fails to identify



how to determine the level regardless of the subject. The applicant further argues that the growth state is talked about in a "general beginning paragraph" and that a growth state is "JUDGED" by a scholastic ability and characteristic. The disclosure fails to identify how these items are used in the "judging". Furthermore, applicant points to Fig. 8 as a teaching of a growth stage. Fig 8 is merely a flow chart with labels of different stages, nothing show how to identify what each of the stages are and how a student qualifies into one of these stages.

28. As to applicants arguments regarding the prior art rejections filed on September 29, 2006 they also have been fully considered and are not persuasive.

29. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant merely states the prior art fails to teach limitations as worded in the claims. The applicant fails to set forth how the claims are different rather than it is just not taught by the prior art.

### ***Conclusion***

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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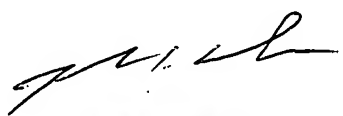
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler (formerly Smith) whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC  


  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600